

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 September 2009 has been entered.

Specification

2. The disclosure is objected to because of the following informalities: At specification p. 49, line 20, "FIG. 4" should be "FIG. 3". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 63, 66 and 69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) In each claim (e.g, claim 63 lines 35-36), the following language is new matter:

"transmitting the user identification input screen image to the one of the printers which accesses the apparatus".

(B) In each claim (e.g, claim 63 lines 37-39), the following language is new matter: "receiving a user identification of a portable information terminal transmitted from the one of the printers which accesses the apparatus".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 63, 66 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) In each claim (e.g, claim 63 lines 35-36), the following language is indefinite:

“transmitting the user identification input screen image to the one of the printers which accesses the apparatus”. It is not clear why “the user identification input screen image” would be transmitted to a printer since there is no disclosure of there being anyone at said printer to see said image. For purposes of examination, this phrase is interpreted as, “transmitting the user identification ~~input screen image~~ to the one of the printers which accesses the apparatus”.

(B) In each claim (e.g, claim 63 lines 37-39), the following language is indefinite: “receiving a user identification of a portable information terminal transmitted from the one of the printers which accesses the apparatus”. It is not clear what “user identification of a portable information terminal” means. Identification of a terminal is inherently independent of a user. For purposes of examination, this phrase is interpreted as, “receiving ~~a user~~ identification of a portable information terminal transmitted from the one of the printers which accesses the apparatus”.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 63, 66 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US006397261B1, hereafter “Eldridge ‘261”) in view of official notice, or, alternatively, unpatentable over Eldridge ‘261 in view of in view of Matsuyama (US006330068B1) and further in view of Putz et al. (US005210824A, hereafter “Putz”),

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Eldridge et al. (US006421716B1, hereafter "Eldridge '716") and Nickerson (US006078406A).

10. Eldridge teaches (independent claims 63 and 68) a printing information distribution apparatus (*distributed operating environment 100*, col. 3 lines 43-58 and Fig. 1) which is adapted to be operably connected to portable information terminals (*mobile computing devices 118*) and printers (*printer 102*), the apparatus comprising:

communication means (*token enabled server 126*, col. 4 lines 36-47 and Fig. 1) for, when one of the portable information terminals (*mobile communication devices 118*, col. 3 lines 58-61) accesses the apparatus through a wireless communication network (col. 3 line 66 to col. 4 line 3), reading a content selection screen image (Fig. 5 and col. 9 lines 51-55) and a print format selection (col. 12 lines 57-62), which are stored in a memory (col. 9 line 49), and for transmitting the read content selection screen image and the read print format selection screen image to the one of the portable information terminals which accesses the apparatus (col. 9 lines 32-35);

reception means (*token-enabled server 126*, col. 10 line 42-50) for receiving a content name and print format information (*respond to a print request ... by recovering a document identified by a selected document token*) transmitted from the one of the portable information terminals (*mobile computing devices 118*) which accesses the apparatus, and for storing the received content name and print format information in a reservation information storage means (*holder device 322*, col. 10 lines 21-22);

generation means for reading the content name and the print format information from the reservation information storage means (*holder device 322*), for generating a print content based on the read content name and the read print format information (col. 10 lines 39-50, with *holder device 322* in place of *any mobile computing device 118*); and

distribution means (*token-enabled server 126*, col. 6 line 66 to col. 7 line 1) for, when one of the printers accesses the apparatus through the wireless communication network, receiving a user identification of a portable information terminal transmitted from the one of the printers which accesses the apparatus (inherently, para. 15 below), and for transmitting the print content generated by the generation means and the print format information which are associated with the received user identification (para. 11 below) to the one of the printers (*printer 102*) which accesses the apparatus (col. 12 lines 53-67).

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11. Eldridge '261 does not teach that the reception means is “for storing the received content name, the received print format information, and a user identification of the one of the portable information terminals in a reservation information storage means with the received content name, the received print format information, and the user identification being associated with each other”. First, “associated with each other” is disclosed (spec. p. 49, lines 18-23) as meaning stored on the same storage device and is so interpreted.
12. Second, under *KSR v. Teleflex* (82 USPQ 2nd 1385), it would have been obvious to improve Eldridge '261 by printing all three items (content name, format information and user ID) on the same sheet to facilitate ordering and billing. That in turn would be facilitated by storing all three items on the same storage device. Alternatively, Matsuyama teaches printing all three items on the same sheet (Fig. 6, where *#[document 0 0 297 210]* is the received content name, *text("Times New Roman" ...)* is the received print format information and *#UserID* is the user identification). Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Neither reference teaches that all three data elements are “associated with each other” by being stored on the same storage device. However, it is common sense (*KSR v. Teleflex*, 82 USPQ 2nd 1385) that having all three data elements “associated with each other” on the same storage device would facilitate having all three data elements printed together in Fig. 6 of Eldridge '261.
13. Eldridge '261 does not teach that the print format is selected from a screen image. However, Eldridge '261 does teach selecting content from a screen image (Fig. 5 and col. 9 lines 51-55) and selecting print format (col. 12 lines 57-62). Under *KSR v. Teleflex* (82 USPQ 2nd 1385), it would have been obvious to also select the print format from a screen image because prior art elements are being combined according to known methods to yield predictable results. Alternatively, Putz teaches selecting the print format from a screen image (Fig. 10 *user interface* with *Format* in the upper left corner and *set the options* in col. 18 lines 27-38). Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Eldridge '261 teaches every feature of the claims, including selecting content from a screen image, but does not teach selecting print format from a screen image. Putz teaches that feature. In addition, It would have been obvious to combine Putz with Eldridge '261 because Putz is cited in Eldridge '261 (col. 5 lines 31-33).

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14. Eldridge '261 does not teach, the print format information comprising at least sheet selection information indicating a type of a printing sheet. Under *KSR v. Teleflex* (82 USPQ 2nd 1385), it would have been obvious to add means for sheet type selection because prior art elements are being combined according to known methods to yield predictable results. The usefulness of a print service would be much enhanced if it offered more than one type of printing sheet. Alternatively, Eldridge '716 teaches, the print format information comprising at least *paper size* (col. 12 lines 6-8), which reads on sheet selection information indicating a type of a printing sheet. Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Eldridge '261 teaches providing access to numerous printers and print services (col. 11 lines 26-32), but does not teach further details as to how the choice of printer and print service is linked. Rather, Eldridge '261 (col. 11 lines 32-36) refers the reader to Eldridge '716 (by its application serial number, 09/270,641) for these details.
15. Eldridge '261 does not teach, that the generation means for transmitting via an electronic mail a print preparation complete notification to the one of the portable information terminals which accesses the apparatus. Because the user of the portable information terminal who ordered the printing would surely like to know that print preparation is complete, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Eldridge '261 that an email message be transmitted notifying the user of the one of the portable information terminals that print preparation is complete. Alternatively, Nickerson teaches (col. 1 lines 37-52 and col. 12 lines 46-50) that it was old and well known to transmit via an electronic mail a print preparation complete notification to the one of the portable information terminals which accesses the apparatus.
16. Matsuyama also teaches, distribution means reading a user identification input screen image stored in the memory, for transmitting the user identification ~~input screen image~~ [interpretation, see para xx above] to the one of the printers which accesses the apparatus (col. 31 lines 49-54, where *the user ... depresses a login button* reads on "input screen image stored in the memory", and Fig. 6, where #UserID is the user identification).

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17. Eldridge '261 also teaches claim 69 as the *transaction server 144* (col. 4 lines 48-53, inherently, because a sever cannot work without memory, which reads on a computer readable medium).

Response to Arguments

18. Applicant's arguments filed with an amendment on 18 September 2009 have been fully considered and addressed by the revised rejection.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
20. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10 January 2010

/Donald L. Champagne/
Primary Examiner, Art Unit 3688